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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/920,607	07/31/2001	Jeremy Minshull	02-106410US	3959

30560 7590 01/13/2003

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EXAMINER	
TRAN, MY CHAU T	
ART UNIT	PAPER NUMBER

1639

DATE MAILED: 01/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/920,607	MINSHULL ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	My-Chau T. Tran	1639

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 22 October 2002.

2a) This action is FINAL.                  2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-130 is/are pending in the application.

4a) Of the above claim(s) 1-66 and 73-130 is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) \_\_\_\_\_ is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) 67-72 are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.

    If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ .
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .	6) <input checked="" type="checkbox"/> Other: <i>Interview Summary</i> .

**DETAILED ACTION**

1. Applicant's election without traverse of Group II (Claims 67-72) in Paper No. 9 is acknowledged.
2. Claims 1-66 and 73-130 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected inventions, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 9.
3. Applicant has elected species of an electrochemical detectable signal from Claim 119. However, Claim 119 is part of the non-elected invention of Group IV (Claims 74-130), which is distinct from Group II as indicated in the previous Office Action. Applicant was notified that Claim 119 would not be examine with Group II. See the phone interview summary attached.
4. Upon further review of the elected invention, the examiner position is that further restriction of the invention is required for the following reasons.

***Election/Restrictions***

5. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - A. Claim 67, drawn to a biosensor with a polypeptide comprising an analyte domain and a catalytic domain, classified in class 530, subclass 350.

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- B. Claim 68, drawn to a biosensor with a polypeptide comprising an analyte domain, first inactive domain, and a second inactive domain, classified in class 530, subclass 402.
- C. Claims 69-72, drawn to a biosensor with a plurality of polypeptides immobilized on the solid support, classified in class 435, subclass 287.1.

The inventions are distinct, each from the other because of the following reasons:

6. Inventions of Group A, Group B, and Group C are unrelated and independent inventions. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions the different inventions as claimed have different required components that have different functions and effects.

The feature of an allosteric conformational change which activates the catalytic domain resulting in conversion of a substrate to a detectable product of Group A is not required by the claims of Groups B and C. The feature of converting the first and second inactive functional domains into a functional catalytic or optically detectable domain of Group B is not required by the claims of Groups A and C. The feature of a plurality of polypeptides immobilized on the solid support and a detection system of Group C is not required by the claims of Groups A and B.

7. Because these inventions are distinct for the reasons given above and the searches required are not co-extensive thus requiring a burdensome search, restriction for examination

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purposes as indicated is proper. Additionally, different patentability considerations are involved for each group. For example, a patentability determination for Group A would involve a determination of the patentability of an allosteric conformational change which activates the catalytic domain resulting in conversion of a substrate to a detectable product while a patentability determination for Group C would involve a consideration of the patentability of the combination of a plurality of polypeptides immobilized on the solid support and a detection system (independent of its use). These considerations are very different in nature.

8. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

9. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to My-Chau T. Tran whose telephone number is 703-305-6999. The examiner is on ***Increased Flex Schedule*** and can normally be reached on Monday: 8:00-2:30; Tuesday-Thursday: 7:30-5:00; Friday: 8:00-3:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew J. Wang can be reached on 703-306-3217. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1123.

mct

January 13, 2003



PADMASHRI PONNALURI  
PRIMARY EXAMINER